

AMENDMENTS TO THE DRAWINGS

The attached replacement sheets of drawings include changes to Figures 21A, 21B, 22 and 23. These sheets replace the original sheets with Figures 21A, 21B, 22 and 23. In order to respond to the Examiner's objection, the frame around each figure has been removed.

Attachment: Replacement Sheets for Figures 21A, 21B, 22, and 23

REMARKS

I. Status of Claims

Upon entry of this amendment, claims 33-51 are pending in the application. Claims 1-32 have been canceled.

Cancellation of the claims is made without prejudice, without intent to abandon any originally claimed subject matter, and without intent to acquiesce in any rejection of record. Applicants expressly reserve the right to file one or more continuing applications hereof containing the subject matter of the canceled claims

In order to expedite prosecution of the application and advance the case toward allowance, new claims 33-51 have been added. Since amendment of claims 15, 27, and 32 required considerable revision of the language, these claims were canceled and replaced with claims 33-35. Support for the new claims is found throughout the specification as filed, in particular, at paragraph 117, paragraphs 128-131, Example 4, Example 5, and Example 6.

Thus, no new matter is added by this amendment and entry of the amendment is respectfully requested.

II. Oath/Declaration

The oath/declaration filed October 8, 2005 has been declared defective for having non-initialed or non-dated alterations. Supplemental oaths with signatures for those inventor signatures with non-initialed/non-dated alterations are attached hereto.

III. Drawings

Figures 3 and 5 are objected to for failure to comply with the sequence rules. Figures 21A, 21B, 22 and 23 are objected to for containing frames around the views. Applicants have added sequence identifiers to the Brief Description of the Drawings for Figures 3 and 5, submitted a

corrected sequence listing including the sequences in the figures, and attached corrected replacement Figures 21A, 21B, 22 and 23 without frames. Withdrawal of the objection is thus respectfully requested.

IV. Specification

The specification is objected to for failure to comply with the requirements of 37 C.F.R. §§ 1.821 through 1.825. As suggested by the Examiner, Applicants have amended the Brief Description of the Drawings to include reference to the SEQ ID NO:s disclosed in Figures 3 and 5 and submitted a sequence listing.

The specification is also objected to for various informalities. Appropriate correction has been made. Withdrawal of the objection is thus respectfully requested.

V. Claim Objections

Claims 7, 14, 19, 26, 28, and 31 are objected to for various informalities. Since these claims have been canceled, this objection is moot. Therefore, Applicants respectfully request withdrawal of the objections.

VI. Rejections under 35 U.S.C. § 112, second paragraph, indefiniteness

Claims 10, 11, 15, 18, 22, 27 and 32 are rejected under 35 U.S.C. § 112, second paragraph, for being indefinite. Since claims 10, 11, 15, 18, 22, 27 and 32 have been canceled, the rejection is moot with respect to these claims. The new claims specify the sequences with sequence identifiers. Therefore, Applicants respectfully request withdrawal of the rejections.

VII. Rejections under 35 U.S.C. § 112, first paragraph, written description

Claims 1-13, 15-25, 27-30 and 32 are rejected under 35 U.S.C. § 112, first paragraph, for lacking written description. Since claims 1-13, 15-25, 27-30 and 32 have been canceled, this rejection is moot with respect to these claims. To the extent the rejection applies to the new claims,

Applicants respectfully traverse the rejection and its supporting remarks. Sufficient written description requires only that a person of skill in the art be able to recognize that Applicants had possession of the invention. As noted by the Examiner in the Office Action itself, "Applicant describes a root-epidermis-specific promoter designated by Applicant as "the btg-26 promoter" and described in SEQ ID NO:1. Applicant describes operably linking a coding region encoding an alanine aminotransferase (AlaAT) to said promoter at pages 45-46 of the specification." (page 5, Office Action). Description of transgenic plants, seed, and methods of this invention are described, for example, at paragraphs 122 to 126 and 132 to 142 of the published application (2005/0044585). Thus, the specification as filed clearly provides written description for the new claims. Therefore, Applicants respectfully request withdrawal of the rejections.

VIII. Rejections under 35 U.S.C. § 112, first paragraph, enablement

Claims 1-32 are rejected under 35 U.S.C. § 112, first paragraph for lack of enablement. Since claims 1-32 have been canceled, this rejection is moot with respect to these claims. To the extent the rejection applies to the new claims, Applicants respectfully traverse the rejection and its supporting remarks. In the Office Action, the Examiner has stated that the specification is "enabling for a transgenic plant with enhanced nitrogen assimilation/metabolism transformed with a construct comprising SEQ ID NO:1, the btg-26 promoter of Brassica napus, operably linked to a nucleic acid sequence encoding the barley alanine aminotransferase as depicted in Figure 5 (SEQ ID NO: 2) and a method for making such a plant. Thus, the specification as filed clearly provides enablement for the new claims. Therefore, Applicants respectfully request withdrawal of the rejections.

IX. Rejections under 35 U.S.C. § 103

Claims 1-14, 16-26 and 28-31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Coruzzi et al. (U.S. Patent 5,955,651) in view of Muench et al (1994), Hirel et al., Edwards et al., and Suzuki et al. Since these claims have been canceled, this rejection is moot. Therefore, Applicants respectfully request withdrawal of the rejections.

X. Nonstatutory Double Patenting

Claims 1-32 have been rejected for non-statutory obviousness type double patenting as being unpatentable over claims 5 and 9 of U.S. Pat. No. 6,084,153.

Since claims 1 to 32 have been canceled, the rejection is now moot. To the extent the rejection applies to the new claims, Applicants respectfully traverse the rejection and its supporting remarks. Claim 5 of U.S. Pat. No. 6,084,153 is directed to a genetic construct comprising a Brassica turgor gene-26 promoter element operably associated with a nitrogen assimilation/metabolism enzyme coding sequence. Claim 9 of U.S. Pat. No. 6,084,153 is directed to a method for producing a plant regenerated from plant cells containing a promoter which is inducible under osmotic stress conditions, comprising regenerating a plant cell containing a promoter which is inducible under osmotic stress conditions, thereby producing a plant, wherein the plant cell was transformed with a genetic construct comprising a Brassica turgor gene-26 promoter element operably associated with a nitrogen assimilation/metabolism enzyme coding sequence. Presently pending claims 33 to 35 are directed to a transgenic plant comprising elevated levels of barley alanine transferase in the root epidermis, wherein the transgenic plant comprises a transgene, wherein said transgene comprises SEQ ID NO: 2 operably linked to SEQ ID NO: 1, seeds of such a plant, and methods of generating such a plant. The other presently pending claims are directed to methods for preferentially producing alanine aminotransferase in the root epidermis of a plant, increasing nitrogen use efficiency of a plant, and increasing biomass of a plant. Both claim 5 and 9 of U.S. Pat. No. 6,084,153 fail to teach the elements of the presently pending claims. Thus the presently pending claims are patentable in view of claims 5 and 9 of U.S. Pat. No. 6,084,153 and a terminal disclaimer would not be proper.

XI. Free of Prior Art

Applicants thank the Examiner for acknowledging that claims 15, 27, and 31 are free of prior art. In order to expedite prosecution, claims 15 and 27 have been cancelled and replaced with claims 33 and 34.

XII. Conclusion

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the unlikely event that the transmittal form is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief (such as payment of a fee under 37 C.F.R. § 1.17 (p)) is required, Applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petition and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing **595792000420**.

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Respectfully submitted,

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